UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Third Party Requester

v.

AFFINITY LABS OF TEXAS, LLC,
Patent Owner

Appeal 2015-006122
Reexaminations 95/001,223[1]
United States Patent 7,324,833 B2[2]
Technology Center 3900

Before STEPHEN C. SIU, JEREMY J. CURCURI, and IRVIN E. BRANCH, *Administrative Patent Judges*.

BRANCH, *Administrative Patent Judge.*

DECISION ON APPEAL[3]

[1] On June 14, 2010, three pending reexamination proceedings (90/010,333, 95/001,223, and 95/001,264) were merged. Decision, *sua sponte*, To Merge Reexamination Proceedings (June 14, 2010) 2–3. Subsequently, on February 22, 2013, the 95/001,223 reexamination was severed into the instant proceeding. Decision on Petitions (Feb. 22, 2013) 2–3.

[2] This patent (hereinafter "'833 patent") issued to Russell W. White, et al., on January 29, 2008, based on Application 10/947,755, filed on September 23, 2004. The '833 patent is the second in a chain of U.S. applications beginning with Application 09/537,812 (now Patent 7,187,947), filed on March 28, 2000. '833 patent 1:6–9.

Patent Owner appeals the Examiner's decision to reject claims 1–5, 8–20, and 22–27. Claims 6, 7, 21, 28–35, and new claims 36–49 are not on appeal. PO App. Br. 4.

We have jurisdiction under 35 U.S.C. §§ 6, 134, and 315.

We affirm the Examiner's decision that claims 1–5, 8–20, and 22–27 are unpatentable over the prior art.

I. STATEMENT OF THE CASE

A. Related Litigation and Reexamination Appeals

We are informed by Patent Owner of the related proceedings listed in Patent Owner's Appeal Brief. PO App. Br. 3 and Appendix X.

B. The Rejections Entered by the Examiner

Patent Owner appeals the Examiner rejecting the claims as follows (PO App. Br. 9–17; *accord* Ans. 2–3; RAN 25–42):

Claims 1, 2, 8–11, 13, 14, 16, 17, 23, and 25–27 under § 102(a) over European Patent Application No. EP 0 982 732 A1 published March 1, 2000 to Hahm (Ground A).

---

[3] Throughout this decision, we refer to: Third Party Request for *Inter Partes* Reexamination (control no. 95/001,223, "Request") filed September 22, 2009; Action Closing Prosecution ("ACP"), mailed October 5, 2012; Right of Appeal Notice ("RAN"), mailed August 15, 2013; Patent Owners' Appeal Brief ("PO App. Br.") filed, December 19, 2013; Examiner's Answer ("Ans."), mailed September 3, 2014; and Patent Owner Rebuttal Brief ("PO Reb. Br."), filed November 3, 2014.

Claims 1–3, 5, 8–17, 19, 20, 22–25, and 27 under § 102(b) over U.S. Patent No. 6,407,750 B1 issued June 18, 2002 to Gioscia (Ground B).[4]

Claims 3–5, 18, and 20 under § 103(a) over Hahm in view of U.S. Patent No. 6,559,773 B1 issued May 6, 2003 to Berry (Ground L).

Claims 3–5, 18, 20, and 22 under § 103(a) over Hahm in view of *The Network Vehicle - a Glimpse Into the Future of Mobile Multi-Media* to Lind et al., IEEE (1998) (Ground M).

Claims 15 and 22 under § 103(a) over Hahm in view of Gioscia (Ground O).

[4] Patent Owner correctly points out that Gioscia does not qualify as prior art under 35 U.S.C. §102(b). PO App. Br. 12. Some claims were initially rejected under 102(b) over Gioscia, but because the '833 patent was later determined to have an earlier priority date (ACP 5–9), the rejection under 102(b) no longer applies. Patent Owner raised the issue in Patent Owner's Appeal Brief and the Examiner responded to the issue in the Examiner's Answer (Ans. 7 (noting a rejection under 102(e) is not materially different than a rejection under 102(b) and stating "analysis of the prior art vis-à-vis the claims remains the same") but failed to restate in the Grounds of Rejection section that the claims stand rejected under 35 U.S.C. § 102(e). *Id.* at 3. The Examiner's response remains substantively unrebutted and Patent Owner did not timely petition. Hence, we analyze the anticipation rejections over Gioscia as if the claims stand rejected under 35 U.S.C § 102(e) and deem the Examiner's failure to restate the rejection correctly an administrative oversight. We address Patent Owner's ensuing procedural arguments *infra*.

Claim 25 under § 103(a) over Hahm in view of U.S. Patent No. 6,255,961B1 issued July 3, 2001 to Van Ryzin (Ground P).

Claim 26 under § 103(a) over Gioscia in view of Berry (Ground Q).

Claim 25 under § 103(a) over Gioscia in view of Van Ryzin (Ground S).

C. The Subject Matter Described in the '833 Patent

The '833 patent relates to coupling a first electronic device, such as a portable MP3 player, and a second electronic device, such as a car audio system, so that content from the first device is playable via the second. Abstract.

D. The Claims on Appeal

Claim 1, which is representative of the independent claims, reads as follows:

1. An audio system, comprising:

a portable electronic device having a display, a memory, and an audio file player;

a first portion of software saved at the portable electronic device and configured to initiate a displaying of a graphical interface item on the display, the graphical interface item comprising a name associated with an audio file saved in the memory;

a mounting location on the portable electronic device that includes a physical interface configured to communicatively couple the

portable electronic device to a different electronic device having an associated display; and

an other portion of software saved at the portable electronic device and configured to communicate a representation of the graphical interface item to the different electronic device via the physical interface to facilitate a displaying of the representation on the associated display, wherein the portable electronic device is configured to communicate interface information to the different electronic device in order to allow a user to view at least a partial representation of a graphical user interface that includes the graphical interface item on the associated display, wherein the graphical user interface comprises a plurality of preprogrammed soft buttons that are linked to respective audio information sources.

II. ISSUES

Patent Owner's arguments (App. Br. 9–17; PO Reb. Br. 2–6) raise the following issues:

1. Under 35 U.S.C. § 102, has the Examiner erred by finding that Hahm describes

> a first portion of software saved at the portable electronic device and configured to initiate a displaying of a graphical interface item on the display, the graphical interface item comprising a name associated with an audio file saved in the memory

as recited in claim 1 and commensurately recited in claim 17;

and

> software saved at the portable electronic device and configured to direct the portable electronic device . . . such that a user can interact with the different electronic device:
>
> . . .
>
> (3) to select an available audio file for processing

as recited in claim 17.

2. Under 35 U.S.C. § 102, has the Examiner erred by finding that Gioscia describes

> software saved at the portable electronic device and configured . . . to communicate a collection of information comprising the name to a different electronic device that has an associated display such that a user can interact with the different electronic device:
>
> . . .
>
> (2) to view at least a portion of the graphical menu on the associated display [and]
>
> wherein the portable electronic device is configured to communicate interface information to the different electronic device in order to allow the user to view the graphical menu on the associated display

as recited in claim 17.

3. Does Patent Owner's evidence of commercial success overcome the Examiner's *prima facie* case that certain claims are obvious?

III. ANALYSIS

A. Preliminary Issues

Patent Owner argues that prosecution must be reopened due to the Examiner introducing new grounds of rejection in the RAN. PO App. Br. 9, 12. The Examiner initially rejected certain claims under 35 U.S.C. § 102(b) over Hahm, but now rejects those claims under 35 U.S.C. § 102(a) over Hahm. *Id.*; *accord* RAN 4. Similarly, Patent Owner argues that prosecution must be reopened so that Patent Owner can address a rejection of certain claims under 35 U.S.C. § 102(e) over Gioscia. PO App. Br. 12; *see* FN 4 *supra*. Patent Owner also argues that this reexamination proceeding can no longer be maintained in view of other proceedings having been concluded. PO Reb. Br. 2–3.

These issues are not properly before us. They are issues to be decided by petition, not appeal. *See* 37 CFR 1.182 and 35 U.S.C. § 312(b). Accordingly, we will not address them further.

B. Rejections over Hahm

Patent Owner argues the Examiner erred in rejecting claims 1 and 17 over Hahm because Hahm does not disclose "wherein the graphical user interface comprises a plurality of preprogrammed soft buttons that are linked to respective audio information sources," as recited in claim 1 and commensurately recited in claim 17. PO App. Br. 10–11; PO Reb. Br. 3–4. We are unpersuaded of error.

Hahm's Figure 2 depicts a user interface for managing content between a computer and an MP3 player. Hahm ¶ 24. Included in the interface are two "move buttons" (Fig. 2, ref. nos. 218 and 220), which are usable for uploading and downloading selected files from the computer to the MP3 player. *Id.* at ¶ 24; *accord* Request 26–27.

The move buttons correspond to the claimed "preprogrammed soft buttons" and are "linked to respective audio information sources" (i.e., the audio files) inasmuch as they cause the selected file to be uploaded or downloaded. We also find that the broadest reasonable interpretation of claim 17's "processing" includes uploading and downloading of files, such as Hahm's uploading and downloading.

In view of the foregoing, we are unpersuaded that Hahm does not describe the claimed preprogrammed soft buttons of claims 1 and 17 or the processing of claim 17. Because Patent Owner does not otherwise argue Ground A, we affirm the Examiner's decision to reject claims 1, 2, 8–11, 13, 14, 16, 17, 23, and 25–27 under § 102 over Hahm.

C. Rejections over Gioscia

Patent Owner argues that the Examiner erred in rejecting claims 1 and 17 over Gioscia because Gioscia does not describe a system with two displays. PO App. Br. 13–14; PO Reb. Br. 4–5. We are unpersuaded of error.

We begin by noting that claims 1 and 17 do not affirmatively recite a system having two displays but instead recite software for interacting with a

different device having a display, an interface to the second device having a display, and/or communicating information to a second device having a display. Patent Owner has not persuasively argued that Gioscia does not disclose software capable of interacting with a different device having a display and/or communicating information through an interface to a different device having a display. Gioscia discloses that its programming guide unit has a display and is interfaced to a media manager unit. Gioscia 2:33–35 and "Figure." The media manager unit may include a second user interface, and the media manager unit is "controlled by the programming guide unit." *Id.* at 2:37–48. Hence, we are not persuaded of error in the Examiner's determination that claim 17 reads on this description.

In view of the foregoing, we are unpersuaded that Giosica does not describe a system having two displays as recited in claim 17. Because Patent Owner does not otherwise argue Ground B, we affirm the Examiner's decision to reject claims 1–3, 5, 8–17, 19, 20, 22–25, and 27 under § 102 over Giosica.

D. Secondary Considerations

We also disagree with Patent Owner that the Examiner erred by failing to consider Patent Owner's evidence of non-obviousness. PO App. Br. 15–17; Reb. Br. 5–6. It is clear that the Examiner considered the evidence but found it unpersuasive. *See, e.g.*, Ans. 8–10. For at least the reasons stated by the Examiner (*id.*), Patent Owner has not persuaded us that the Examiner's

decision, that the evidence of non-obviousness failed to overcome the obviousness rejection, was erroneous.

Patent Owner does not argue with particularity the remaining rejections (Grounds L, M, O, P, Q, and S) except to say that the secondary references fail to cure the shortcomings of Hahm and Gioscia (PO App. Br. 12, 14), which we do not find. Accordingly, based on the record before us, we are unpersuaded of error in the Examiner's decision to reject claims 1–5, 8–20, and 22–27, all appealed rejections.

VII. DECISION

The Examiner's decision that claims 1–5, 8–20, and 22–27 are unpatentable over the prior art is affirmed.

In the event neither party files a request for rehearing within the time provided in 37 C.F.R. § 41.79, and this decision becomes final and appealable under 37 C.F.R. § 41.81, a party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

AFFIRMED

Appeal 2015-006122
Patent 7,324,833 B2
Reexamination No. 95/001,223

For Patent Owner:

TROP, PRUNER & HU P.C.
1616 S. VOSS ROAD
SUITE 750
HOUSTON, TX 77057-2631

For Third Party Requesters:

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004